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REMARKS

A. Request for Reconsideration

Applicant has carefully considered the matters raised by the Examiner in the outstanding Office Action but remains of the position that patentable subject matter is present. Applicant respectfully requests reconsideration of the Examiner's position based on the Terminal Disclaimer, the amendments to the specification, the amendments to the claims and the following remarks.

B. Affirmation of Election

Applicant confirms the provisional election of Group I, claims 1-4, 6, and 9-12. Withdrawn claims 5, 7, and 8 have been cancelled.

C. Claim Status and Amendments

Claims 1, 3, 4, 6, and 9-12 are presented for further prosecution.

Claim 1 has been amended to include the limitations of claim 2. Claim 2 has been cancelled and claim 3 has been amended as a result to be dependent upon claim 1. As noted above, claims 5, 7, and 8 have been cancelled.

D. Objection to the Specification and Specification Amendments

The Examiner noticed that example compounds 4 and 6 on page 12 of the application are identical. Page 12 has been amended to delete example compound 6.

The Examiner also noticed that compound EP-9 on page 25 was misspelled. Page 25 has been amended to correct the spelling of compound EP-9.

Finally, page 69 and Table 3 have been amended herein to correct obvious typographical errors.

E. Double Patenting Rejection

Claims 1-4 and 6-12 had been provisionally rejected for obviousness-type double patenting as being unpatentable over claims 17-19 and 22-24 of Takabayashi (U.S. 2004/0244641).

Applicant has enclosed a Terminal Disclaimer to overcome the double patenting rejection. PTO 2038 is enclosed for the Terminal Disclaimer fee.

F. The Prior Art Rejections

Claims 1, 6, 7, and 9-12 had been rejected as being anticipated by Laksin (U.S. 6,727,295). Claims 1, 6, 9, and 12 had been rejected as being anticipated by Frings (U.S. 6,770,686). Claims 1, 6, and 12 had been rejected as being anticipated by Crivello (U.S. 4,319,974). Claims 1 and 6 had

been rejected as being anticipated by the Journal of Polymer Science: part A: Polymer Chemistry article by Crivello. Claims 1, 6, 9, and 12 had been rejected as being anticipated by Koleske (E.P. 118,748). Claims 1, 6, and 9 had been rejected as being anticipated by Kagami (J.P. 2002-047474). Claims 1 and 6 had been rejected as being anticipated by CAPLUS Accession No. 1998:808928 for the Polymer Article by Crivello. Claims 1, 6, 10, and 12 had been rejected as being unpatentable over Seng (WO 96/21702). Claims 1, 4, 6, and 9 had been rejected as being unpatentable over Sullivan (U.S. 2004/00225025), Misev (U.S. 6,235,807), Schulthess (U.S. 5,783,358), Hatton (U.S. 2004/0106769) and Shimoda (U.S. 2004/0059085). Claims 10 and 11 had been rejected as being unpatentable over Koleske, Seng, Misev or Shimoda in further view of Yatake (U.S. 7,030,174), Oka (U.S. 2002/0020832) and Shirakawa (U.S. 2001/0045178). Claims 1-4, 6, 9, and 12 had been rejected as being unpatentable over Koleske or Takai (U.S. 2004/0242839). Claims 10 and 11 had been rejected as being unpatentable over Koleske and Takai in further view of Yatake, Oka, and Shirakawa.

In section 28 of the Office Action, the Examiner stated that the cited references, except for Takai, do not teach or suggest the epoxy compound of the formula (1) of claim 2, and that more favorable consideration would be given to the rejections if the limitations of claim 2 were added to claim 1.

Furthermore, it is noted that claim 2 was not included in the first ten (10) rejections.

Applicant has amended claim 1 to recite the epoxy compound of the formula (1) of claim 2. Applicant respectfully submits that the first ten (10) rejections are now moot based on the amendment to claim 1.

Turning now to Takai, it is noted that Takai does not teach formula (1) of the present invention. The Examiner, however, stated that it would be obvious to one of skill in the art to modify formula (I) of Takai to arrive at formula (1) of the present invention. Applicant disagrees. It is submitted that there is no teaching or suggestion in Takai to modify Formula I of Takai to arrive at formula (1) of claim 1 of the present invention. Without any suggestion or motivation in the references, it is improper to modify a reference.

Respectfully, none of the cited references teach or suggest the epoxy compound of formula (1), and that claim 1 is patentable over the teachings of the cited references taken alone or in combination.

G. Conclusion

In view of the foregoing and the enclosed, it is respectfully submitted that the application is in condition for allowance and such action is respectfully requested. Should any

extensions of time or further fees be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit Account # 02-2275.

Respectfully submitted,

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Encl: Terminal Disclaimer
PTO 2038